

REMARKS

In response to the Office Action mailed October 9, 2003, Applicant respectfully requests reconsideration of the application in view of the remarks set forth below. As discussed above, no amendments to the claims have been made. Claims 1-15, 19-24 and 28-37 are pending in this application.

Discussion of Rejection of Claims under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1-3, 9-10, 13-14, 19-20, 24, 28, 30-38 under 35 U.S.C. § 102(b) based on either Allard, et al. (U.S. Patent No. 4,743,964) or Carollo (U.S. Patent No. 5,912,650). Claim 38 has been cancelled in the previous response.

Rationale of 35 U.S.C. 102

“For a prior art reference to anticipate a claim under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.ed 675, 677, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988). Applicant respectfully submits that neither of the Allard and Carollo references anticipates independent Claims 1, 9, 19, 20, and 32 as discussed below because both of the prior art references lack at least one of the limitations recited in each of the independent claims.

Discussion of Patentability of Independent Claims Over Allard

Claim 1 recites, among other things, left and right plane image display devices for simultaneously outputting *the received inverted* left and right plane images. Each of independent Claims 9, 19, 20 and 32 has a similar limitation. As discussed during the interview, Allard does not disclose the claimed inverting and display devices under the Examiner’s first characterization of Allard in the Office Action dated July 25, 2002. See arguments made on the responses filed October 24, 2002 and July 1, 2003. In addition, the Allard reference lacks the claimed inverting devices under the Examiner’s second characterization of Allard in the Office Action dated January 16, 2003. See arguments made on the response filed on July 1, 2003. The Examiner confirmed in the interview that the claim rejections by Allard have been overcome. Thus, Applicant respectfully submits that each of the independent claims is patentable over the Allard reference.

Discussion of Patentability of Independent Claims Over Carollo

The Examiner asserts that the functions of the claimed mirror and display devices “must necessarily result” from the Carollo reference since the mirrors (109) inherently invert the images, the image generators (101, 105) inherently invert the images in order that the resulting image be viewed with proper orientation. However, it is respectfully submitted that the Carollo reference does not inherently disclose either “the display devices that output the inverted images” or “displaying inverted images” recited in Claims 1, 9, 19-20 or 32 as discussed below.

1. Rationale of Inherence Rejection under 35 U.S.C. § 102

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. APP. & Inter. 1990). MPEP 2112. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. That is, the missing element or function *must necessarily result from the prior art reference*. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981). Furthermore, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. *Continental Can Company v. Monsanto*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).

2. Carollo Does Not Inherently Disclose Either the Claimed Inverting Devices Or Inverting the Images

The Examiner asserts in this Office Action that the Applicant’s declaration that “the display devices of Carollo do not necessarily invert the images, and that Carollo does not inherently show image inversion” is merely argumentative and is not persuasive. Applicant respectfully disagrees. Evidence (affidavits, declarations, and other evidence) traversing rejections must be considered by the examiner whenever present. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as “the declaration lacks technical validity” or “the evidence is not commensurate with the scope of the claims” without an explanation supporting such

findings are insufficient. MPEP 716.01.

3. Carollo Shows Neither the Claimed Inverting Devices Nor the Display Devices

Claim 1 recites, among other things, left and right image inverting devices for receiving *left and right plane images of an object* and inverting the left and right sides of the left and right images, respectively, each plane image being produced at different positions *with respect to the object*, and left and right plane image display devices for simultaneously outputting *the received inverted left and right plane images*. Each of independent Claims 9, 19-20 and 32 has a similar limitation.

Carollo is directed to a dichoptic display device in which two different images (300-big image, 303-small image) for two different objects are provided to viewer's eyes (Fig. 3). Even if the image generators (101, 105) of Carollo can invert images, the generators (101, 105) do not invert left and right plane images of an object. Instead, the image generators (101, 105) may invert two different images of two different objects. Thus, Carollo does not show the claimed inverting devices.

Furthermore, the image generators (101, 105) of Carollo cannot output the received inverted left and right images of the object because the generators (101, 105) output the two different images (300, 303) of two different objects. Thus, Carollo does not show the claimed display devices.

Summary

In view of the above, the Examiner has failed to provide the basis for rejecting the independent claims over either Allard or Carollo in that not every element of each claim is identically disclosed there. Therefore, Applicant respectfully submits that independent Claims 1, 9, 19, 20 and 32 are patentable over the prior art. The remaining claims depend from one of corresponding base Claims 1, 9, 19, 20, and 32 and further define additional technical features. In view of patentability of their base claims and further additional features, the dependent claims are also patentable. Withdrawal of the rejections is respectfully requested.

Discussion of Rejection of Claims under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 4 and 23 under 35 U.S.C. § 103(a) as being

unpatentable over Allard. The Examiner has also rejected Claims 5-8, 11, 12, 15, 21, 22 and 29 under 35 U.S.C. §103(a) as being unpatentable over Allard in view of Ricks (U.S. Patent No. 4,190,856).

Claims 4 and 23 depend from Claims 1 and 20, respectively, and further define additional technical features. In view of patentability of their base claims and further additional features, dependent Claims 4 and 23 are also patentable over the prior art.

Claim 5 recites, among other things, first left and right plane image display devices for simultaneously outputting the received inverted left and right plane images. As discussed above with regard to patentability of Claims 1, 9 and 19, the limitation “display devices for outputting the received inverted images” is not disclosed in the Allard reference either explicitly or inherently. In addition, the Ricks reference does not disclose the above limitations, either. The Ricks patent at best discloses generating a three dimensional image using “sectioning” technology that forms a three-dimensional picture by stacking a set of cross-sectional representations along a common optical axis (Figure 2; column 2, line 43 through column 3, line 23).

In view of the above, Allard and Ricks, either alone or in combination, does not teach or suggest the claim limitation “display devices for outputting the received inverted images” recited in Claim 5. Therefore, independent Claim 5 is patentable over the prior art references. Regarding Claims 6-8, they depend from Claim 5 and further define additional technical features. In view of patentability of their base claim and further additional features, the dependent claims are also patentable.

Regarding Claims 11-12, 15, 21-22, and 29, they depend from one of the base claims (Claims 5, 9, and 20) and further define additional technical features. In view of patentability of their base claims and further additional features, the dependent claims are also patentable. Thus, withdrawal of the rejections is respectfully requested.

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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. If the Examiner has any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the indicated telephone number.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

1/8/04

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